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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,358	06/30/2004	Aki Kobayashi	042276	2290
38834 7590 04/21/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
CHONG, YONG SOO				
ART UNIT		PAPER NUMBER		
1617				
MAIL DATE		DELIVERY MODE		
04/21/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/500,358

**Applicant(s)**

KOBAYASHI ET AL.

**Examiner**

YONG S. CHONG

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2, 4, 7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 7 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 1/7/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Application***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/2008 has been entered.

Claim(s) 1, 3, 5-6, 8-9, 11-18 have been cancelled. Claim(s) 2, 4, 7, 10 are pending. Claim(s) 2, 4, 7, 10 have been amended. Claim(s) 2, 4, 7, 10 are examined herein.

Applicant's arguments have been fully considered but found not persuasive. The rejection(s) of the last Office Action are maintained for reasons of record and modified below as a result of the new claim amendments.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham vs John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 4, 7 are rejected under 35 U.S.C. 103(a) as being obvious over Clarkson et al. (US Patent Application 2001/0036964 A1) in view of McCue et al. (US Patent 5,403,587).

The instant claims are directed to a cosmetic or medicinal composition comprising 1,2-octanediol and one or more materials selected from the group consisting of eugenol, citronellal, terpinyl acetate, citronellol, and  $\beta$ -pinene.

Clarkson et al. teach an anti-microbial composition comprising polyhydric alcohol (abstract), where a preferred compound is 1,2-octanediol (section 0065). Typical amounts of the polyhydric alcohol are between 1 and 20% by weight (section 0062). This composition is concerned with reducing microbial numbers upon the surface of the human body such as underarm or feet, thereby reducing malodor (section 0001), therefore requiring the use of perfumes or fragrances (section 0086). When used on the surface of the skin to fight microorganisms, the invention is formulated into deodorants (section 0002). In this manner, this composition disclosed by Clarkson et al. reads on both a cosmetic or medicinal composition.

Examiner notes that in the absence in the specification as to what exactly is the scope of a "cosmetically and medicinally effective agent," the claims will be interpreted broadly so that the active agent disclosed by Clarkson et al. will read on a "cosmetically and medicinally effective agent."

However, Clarkson et al. fail to teach citronella, terpinyl acetate, citronellol, or  $\beta$ -pinene in the composition.

McCue et al. teach essential oils, such as citronella (col. 1, lines 56-59), which is a source of citronellal, is a well-known antiseptic compound (col. 1, lines 44-46) and is utilized for its antimicrobial activity (col. 1, lines 8-9). The essential oil is used in an amount between 0.02 to 5% by weight (col. 3, lines 10-14).

Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to combine the antimicrobial compositions taught by Clarkson and McCue et al. with each other.

A person of ordinary skill in the art would have been motivated to make this combination because: (1) both Clarkson and McCue et al. disclose antimicrobial compositions and (2) of the reasonable expectancy of successfully producing an effective cosmetic and/or medicinal composition.

"It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... The idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Claim 10 is rejected under 35 U.S.C. 103(a) as being obvious over Clarkson et al. (US Patent Application 2001/0036964 A1) and McCue et al. (US Patent 5,403,587) as applied to claims 1-9 in view of Jensen et al. (US Patent 2,550,255).

The instant claims are directed to a food composition comprising 1,2-octanediol and one or more materials selected from the group consisting of eugenol, citronellal, terpinyl acetate, citronellol, and  $\beta$ -pinene.

Clarkson and McCue et al. teach as discussed above, however fail to disclose specifically a food product containing this composition.

Examiner notes that in the absence in the specification as to what exactly is the scope of a "nutritionally effective edible substance," the claims will be interpreted broadly so that the active agent disclosed by Clarkson et al. will read on a "nutritionally effective edible substance."

Jensen et al. teach anti-bacterial agents to be employed as an effective preservative for food products (col. 1, lines 34-56).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to use the antimicrobial composition as taught by Clarkson and McCue et al. in food products.

A person of ordinary skill in the art would have been motivated to use the composition taught by Clarkson and McCue et al. in food products because the anti-bacterial properties of 1,2-octanediol can be used as a preservatives in food products to prevent spoilage and decomposition.

***Response to Arguments***

Applicant argues that the newly amended claim limitation reciting "wherein said 1,2-octanediol and said materials are comprised in weight ratio between 1:1 to 10:1" sufficiently corresponds to the test results in the specification and the previous declaration showing synergism. Applicant also notes that formulation example 1 showing 1,2-alkanediol and eugenol in a ratio of 2.5:1, provides further support for the claimed range.

Although the Declaration shows synergistic results between 1,2-octanediol and eugenol, citronellal, terpinyl acetate, citronellol, and  $\beta$ -pinene, the Declaration is still not commensurate with the scope of the amended claims. The raw data as depicted in the Declaration and Figures are all from the experimental guidelines of Embodiment 1 as disclosed in the specification. Examiner notes that Embodiment 1 sets forth specific dilution concentrations for 1,2-octanediol and a 50:50 weight mixture between 1,2-octanediol and thymol. There is no unexpected data for the upper limit of the claimed ratio of 10:1. Furthermore, 1,2-alkanediol and eugenol in a ratio of 2.5:1 merely shows that this formulation was made, but does not show any synergistic data for this particular formulation.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong S Chong/  
Primary Examiner, Art Unit 1617

YSC